

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF HOFFMANN et al.

Appeal No. 1999-1990
Application No. 08/635,599¹

HEARD: August 16, 1999

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 6, which are all of the claims pending in this application.

We AFFIRM.

¹ Application for patent filed April 22, 1996.

BACKGROUND

The appellants' invention relates to a spray nozzle. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Anilin & Fabrik (Fabrik)	606,350 ² (France)	June 11, 1926
Dunham	166,515 (Gr. Britain)	Nov. 30, 1922

Claims 1 through 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fabrik.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fabrik in view of Dunham.

² In determining the teachings of Fabrik, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed October 27, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed August 3, 1998) and reply brief (Paper No. 15, filed December 29, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation issue

We sustain the rejection of claims 1 through 5 under 35 U.S.C. § 102(b).

Determining whether a reference anticipates a claim involves a two-step analysis. The first step is to construe the claim to determine its meaning; the second step is to compare the properly construed claim to the disclosure of the reference to assess whether that disclosure meets all the limitations of the claim.³ In applying the second step, we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference

³ See, e.g., Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1574, 36 USPQ2d 1417, 1419 (Fed. Cir. 1995).

teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claim 1

The main issue presented by the appellants in this appeal is one of claim construction-viz., whether claim 1 under appeal requires the spray nozzle to spray water. We conclude that it does not.

In drawing this conclusion we rely on the premise that the PTO is required to give claims their broadest reasonable interpretation during prosecution. See, e.g., In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In addition, we note that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). A statement of

intended use does not qualify or distinguish the structural apparatus claimed over the reference. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991). Such statements often, although not necessarily, appear in the claim's preamble. In re Stencel, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

After reviewing the above-noted precedent and the cases cited by the examiner and the appellants, we reach the conclusion that claim 1 is drawn to the spray nozzle, per se. In other words, claim 1 is directed to the spray nozzle, itself, and not to its intended use as a water spray nozzle. We reach this conclusion based upon the language of claim 1 itself. Claim 1 recites "especially for spraying water in fire prevention systems," "for supplying water," and "so that

the stream of water coming out of the second outlet orifice (21) . . . spreads out as a spray mist inside the spray cone leaving the first outlet orifice (5)." In our view, the appellants' use of the terms "for" and "so that" clearly convey statements of purpose or intended use. In addition, we find the examiner's determination that Fabrik's liquid fuel burner is inherently capable of performing in the manner set forth in claim 1 to be reasonable.

Thus, it is our determination that claim 1 can be read such that Fabrik anticipates claim 1. While we recognize that Fabrik's liquid fuel burner does not disclose spraying water, we cannot read this attribute of the disclosed spray nozzle into claim 1 as a limitation. See, e.g., In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Accordingly, we find ourselves in agreement with the examiner that claim 1 "reads on" Fabrik as set forth on pages 3-8 of the answer.

Finally, as to the appellants' argument that Fabrik is non-analogous art, we agree with the examiner that whether a

reference is analogous art is irrelevant to whether that reference anticipates. See In re Self, 671 F.2d 1344, 1350, 213 USPQ 1, 7 (CCPA 1982). A reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims.

Since all the limitations of claim 1 are found in Fabrik for the reasons stated above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

Claims 2 through 5

The appellants have grouped claims 1 through 5 as standing or falling together.⁴ Thereby, in accordance with 37 CFR

⁴ See page 3 of the appellants' brief.

§ 1.192(c)(7), claims 2 through 5 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2 through 5 under 35 U.S.C. § 102(b) is also affirmed.

The obviousness issue

We sustain the rejection of claim 6 under 35 U.S.C. § 103.

In applying the test for obviousness⁵, we reach the same conclusion as the examiner (answer, p. 3). That is, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Fabrik's liquid fuel burner to have an adjustable second passage as suggested and taught by Dunham's nozzle so as to permit adjustment of the fuel/air mixture to obtain optimum combustion efficiency as well-known in the art.

⁵ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The appellant's arguments are not persuasive that any error in the examiner's determination regarding the obviousness of the claimed subject matter has occurred. As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991) and In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

Additionally, the appellants argue that the deficiencies of Fabrik discussed above with respect to claim 1 are not remedied by Dunham. We find this argument unpersuasive in view of our holding above that claim 1 is anticipated (i.e., not deficient) by Fabrik.

For the reasons stated above, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 5 under 35 U.S.C. § 102(b) is affirmed, and the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1999-1990
Application No. 08/635,599

Page 14

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APPEAL NO. 1999-1990 - JUDGE NASE
APPLICATION NO. 08/635,599

APJ NASE

APJ McQUADE

APJ ABRAMS

DECISION: **AFFIRMED**

Prepared By: Gloria

Henderson

DRAFT TYPED: 01 Dec 00

FINAL TYPED:

Heard: August 16, 1999